

III. Remarks**A. Claim Rejection under 35 U.S.C. §103(a)****1. Claims 1-2, 5-6, 8-10, 13-14, 16-18, 20-22, 24 and 28-33**

The Action rejects Claims 1-2, 5-6, 8-10, 13-14, 16-18, 20-22, 24 and 28-33 as being obvious from U.S. Patent No. 5,581,682 to Anderson et al. (hereinafter “Anderson”) in view of the Pontin article regarding the SnagIt product (hereinafter “SnagIt”). Reconsideration and withdrawal of the rejection of these claims are respectfully requested in view of the foregoing amendments and following arguments.

(a) Independent Claims 1, 9 and 17

In the Response to Arguments set forth in the Action, the Examiner states that claim 1 does not “appear to be directed to a PDF file, nor to a document with an underlying instruction set.” Per the Examiner’s request, and in an effort to expedite the remaining prosecution of this application, Applicants have amended independent claims 1, 9 and 17 to recite that the document is in portable document format (PDF) comprising a PDF data stream. Consistent with this amendment, the creating step has also been amended to recite “creating an electronic output PDF file comprising the PDF data stream except for portions of said PDF data stream corresponding to said identified content.”

Applicants submit that the rejection of independent claims 1, 9 and 17, and their dependent claims, based on the combination of Anderson and SnagIt is thus moot. Nonetheless, this rejection is briefly traversed below.

Applicants have discussed Anderson in depth in prior responses, and a detailed discussion of Anderson is not warranted. The Examiner correctly concedes that Anderson does not create an electronic output file (nor an electronic output PDF file as amended). Anderson clearly teaches an abstraction overlay methodology that does not remove the original content

from the electronic version of the abstracted document. In the rejection, the Examiner relies on SnagIt for providing this feature.

As described in the present application, for example at Page 6, first full paragraph, electronic documents such as PDF files include an underlying set of instructions, for example a PDF instruction stream, that includes information on the content (e.g., textual-type content, text font, text size, image-type content, etc.) and content location. As part of the redaction process, Claim 1 recites the step of identifying information (i.e., the underlying instruction data) in the document that represents content and location and nature of content. Claims 1, 9 and 17 have been amended to recite as follows: creating an electronic output PDF file comprising said PDF data stream except for portions of said PDF data stream corresponding to said identified content, a redacted document being producible from said output file for display. In other words, Claim 1 recites that the underlying instruction set (i.e., the “PDF data stream”) of the electronic document is maintained by the redaction process and contained in the electronic output PDF file except for the portions of the instruction set that correspond to the identified content, i.e., the content that is being redacted. In this manner, complete continuity between the original file and the redacted file is maintained, except for instructions that correspond to the content being redacted. As described below, the combination suggested by the Examiner would not operate in this manner.

In the Examiner’s suggested combination of Anderson and SnagIt, the user would first create a redacted document on-screen using the software of Anderson and then use SnagIt to capture the redacted document “via screen shot capture,” creating an image file of the screen shot. It would be apparent to those in the art that this methodology would not capture, for lack of a better term, the underlying PDF data stream that represents content and location and nature of content. Put another way, no portion of the underlying data stream for the original electronic document would survive into the newly created image file. The image file would have its own unique instruction set in its own format, e.g., .gif, .jpeg, etc. that has no direct correlation to or overlap with the original underlying PDF stream in the *electronic document* being redacted. By way of analogy, the suggested combination is no different than taking a digital photograph of the

Anderson redacted document and then uploading that digital photo onto the computer as a .gif or jpeg file for storage. Clearly, such a methodology does not preserve any part of the underlying instructions of the original electronic document.

In contrast to the suggested combination, the redaction method of Applicant's amended Claims 1, 9 and 17 preserve the original PDF stream except for the portion of the stream that corresponds to the redacted content.

For at least these reasons, it is submitted that combination suggested by the Examiner does not teach each feature of Claims 1, 9 and 17. Claims 1, 9 and 17, therefore, are not obvious from and are allowable over the cited combination. For analogous reasons, Claims 2-4, 10-12, 18-20, 28-33, which depend from these claims, are also allowable.

(b) Independent Claims 5, 13 and 21

In the Response to Arguments section, the Examiner disagrees with Applicants' assertion that claim 5 recites that the designations of the geographic region of the document for redaction are saved with the document. The Examiner disagreed because, according to the Examiner, claim 5 does not claim any underlying instruction set to which the designations would be saved. Applicants have amended claims 5, 13 and 21 consistent with the supporting description, page 5, line 18 to page 6, line 2, to recite that the designations are saved "in association with the document." In other words, there is no recited modification of an underlying instruction set being claimed. Rather, the document is saved along with the designations. As explained at the cited portion, this allows for a second reviewer, such as a manager, to then review the designations before approving a redaction that would permanently redact the document.

The Examiner concludes that saving the captured screen using SnagIt meets the limitation. With the clarification above, it is submitted that saving a captured screen shot would not save designations as claimed in association with the document.

The Examiner also argues that Anderson's command entry or pull down menu can be reasonably interpreted as "manipulation of a frame (i.e., the frame of Texas)." These claims have been amended to further clarify that the manipulating involves manipulating a "movable viewing frame superimposed on the displayed document." These claims also recite the "content having a geographical location within said frame being visible to the user during said step of manipulation." The "frame" of Texas identified by the Examiner is a part of the image of Texas and is static. It is not a "movable viewing frame superimposed on the displayed document" through which content is visible. Further, the "command entry and pull down menu" of Anderson is not a "movable viewing frame superimposed on the displayed document," with content visible in the frame, to assist in designating content to be redacted. It is submitted, therefore, that Claim 5 and Claims 6 and 8, which depend from Claim 5, are allowable over the cited combination. For at least the reasons set forth above in connection with Claim 5, it is submitted that Claims 13 and 21, and Claims 14 and 16 and 22 and 24, which depend from Claims 13 and 21, respectively, are also allowable. Reconsideration and withdrawal of the rejection of these claims are respectfully requested.

(c) Claims 31-33

Claims 31-33 depend from independent Claims 1, 9 and 17 and are, therefore, allowable for at least the reasons set forth above.

Still further, Claims 31-33 each recite that the removal step comprises "replacing pixels corresponding to the identified content." Applicants submit that the Examiner concedes that Anderson does not teach this feature. Indeed, Anderson accomplishes visual modification using overlays, not replacement of pixels. The Examiner then argues that because SnagIt "teaches permanent flattening of a file, it would have been obvious to one of ordinary skill in the art . . . to implement redaction via pixel by pixel replacement." These claims have been amended to further recite that the pixels are replaced "with replacement pixels, said replacement pixels being included in said PDF data stream of said output PDF file." As discussed above, SnagIt produces

an image file that is a “screen capture.” As a screen capture, it is not replacing anything; rather, SnagIt essentially takes a photo of whatever is displayed on the screen. Combining this screen capture feature with the redaction method of Anderson does not preserve the underlying PDF data stream while replacing portions thereof with portions corresponding to replacement pixels. Again, nothing is replaced. Rather, an entire new image file is created.

For at least these additional reasons, it is submitted that Claims 31-33 are independently allowable over the cited combination.

2. Claims 3-4, 11-12, and 19

The Action rejects Claims 3-4, 11-12, and 19 as being obvious from the Anderson/SnagIt combination in further view of Redax. Claims 3-4, 11-12 and 19 depend from Claims 1, 9 and 17, which are allowable as set forth above.

3. Claims 26-27

The Examiner rejects Claims 26-27 as being obvious from the combination of Anderson and Redax. Amended independent Claims 26 recites that the electronic document comprises a PDF data stream and that the created output PDF file comprises “said PDF data stream except for portions of said PDF data stream corresponding to said identified content.” Claim 26 recites further that the area selected for redaction has at least one image. As explained in previous responses, Redax has no ability to redact images from PDF documents. Further, as explained above and in previous response, Anderson can only redact images using image overlays. Therefore, the combination of Redax and Anderson cannot “select[] a first geometric area on the document for redaction, said first geometric area having content comprising at least one image” in combination with “creating an output PDF file comprising said PDF data stream except for portions of said PDF data stream corresponding to said identified content, wherein a redacted document is producible from said output file” as claimed in claim 26.

Therefore, it is submitted that the cited combination does not teach the method and claimed. Therefore, it is submitted that claim 26 is not obvious from and is allowable over the cited combination.

Claim 27 depends from claim 26 and is, therefore, allowable over the cited combination. It is submitted further that claim 27 is independently allowable for at least the reasons argued above in connection with claims 28-30.

Still further, Applicants submit a Rule 132 inventor declaration directed to secondary considerations of non-obviousness in support of the non-obviousness of these claims, which allow for the redaction of both images and text from the PDF document. Consideration of the declaration is respectfully requested.

Reconsideration and withdrawal of the rejection of claims 26-27 are respectfully requested.

The features of claim 3 (directed to redacting text in addition to image content) have been amended into claim 1 and claim 3 has been canceled. Claim 4 has been amended to depend from claim 1. Likewise, claim 9 has been amended to include the features of claim 11 (directed to redacting text in addition to image content) and claim 11 has been canceled. Claim 12 has been amended to depend from claim 9. Claim 17 has been amended to include the features of canceled claim 19 (directed to redacting text in addition to image content). Independent claims 1, 9 and 17 now recite that both image and textual content are redacted. Consideration of the Rule 132 declaration submitted with this response in connection with these claims is also respectfully requested.

4. Claim 34

The Action rejects claim 34 as being unpatentable over the Anderson/Redax combination in further view of Pontin. Claim 34 depends from claim 26 and is allowable for at least the

reasons set forth above in connection therewith. It is submitted further that claim 34 is allowable for the additional reasons set forth above in connection with claims 31-33.

B. New Claims

New Claims 35 and 36 have been added and depend from claims 5 and 21, respectively. These claims recite that the movable viewing frame is resizable. Support for these claims can be found at, for example, page 5 and FIGS. 2 and 4 of the application as filed. Examination and allowance of these claims are respectfully requested.

IV. Conclusion

In view of the foregoing remarks, Applicants submit that this application is in condition for allowance at an early date, which action is earnestly solicited.

The Commissioner for Patents is hereby authorized to charge any additional fees or credit any excess payment that may be associated with this communication to deposit account **04-1679**.

Respectfully submitted,

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